

REMARKS

Applicant appreciates the continued examination of the present application including the allowance of Claims 1-16 and 18-23. *See Official Action, page 3.* Accordingly, the only remaining issues for discussion herein are the rejection of Claims 27 and 28 and the patentability of newly added Claim 29. Applicant respectfully maintains that Claims 27-29 are patentable for at least the reasons discussed below.

Sadler is not a proper reference under § 103.

Claims 27-28 stand rejected under 35 U.S.C. § 103 over U.S. Patent Application Publication No. 2004/0198293 to Sadler et al. ("Sadler") in view of European Patent Application No. EP 1 128 466 A2 by Petteri ("Petteri"). *Official Action, page 2.* Applicant notes that, Sadler is not prior art under section 103 because Sadler and the claimed invention were commonly owned by (or subject to an obligation of assignment to) Sony Ericsson Mobile Communications, AB., at the time the invention was made. *See attached Assignments to Sony Ericsson Mobile Communications, AB.* Furthermore, the present application was filed after November 29, 1999. Section 4807 of the American Inventors Protection Act of 1999 (AIPA) amended section 103(c) to recite:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f) and (g) of Section 102 of this title, shall not preclude patentability under this section where the subject and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Section 4807 further states that the amendment shall apply to any application for patents filed on or after the date of enactment of this act (November 29, 1999). *1948 I.S. section 4807.* Accordingly, as Sadler and the present invention were commonly owned by (or subject to an obligation of assignment to) Sony Ericsson Mobile Communications, AB at the time that the present invention was made, Sadler cannot be relied on as prior art in an obviousness rejection of the present claims as a matter of law, because the present application was filed on October 31, 2003 (*i.e.* after

November 29, 1999). Thus, the rejection of Claims 27-28 under section 103 should be withdrawn for at least these reasons.

Moreover, as understood by Applicant, Petteri also does not disclose the teachings alleged to be provided in Sadler. For example, as understood by Applicant, the parasitic element 230 (shown, for example, in Fig. 2 of Petteri) is not a "floating parasitic element." Petteri states that the "parasitic element is short-circuited at a point S to the ground plane through conductor 202." *Petteri, column 3, lines 26-28*. In contrast, Applicant's specification includes a definition of "floating" as follows:

It will be understood that, as used herein, the term "floating" (in reference to the floating parasitic element 340) includes configurations where the parasitic element is electrically isolated from (or electrically floats relative to) a ground plane associated with the multi-band antenna 300. *See, page 8, lines 1-4 as amended.*¹

Therefore, Applicant respectfully submits that Petteri also does not disclose the recitations of Claim 27 for at least these additional reasons.

In view of the above, Applicant submits that Claim 27 is patentable over the cited references. Furthermore, dependent Claims 28-29 are patentable at least per the patentability of independent Claim 27 as described above.

Dependent Claims 28 and 29 are separately patentable

In addition to the reasons described above with reference to independent Claim 27, dependent Claims 28 and 29 provide separate basis for patentability. With regard to dependent Claim 28, Applicant submits that Petteri also does not disclose or suggest "wherein the floating parasitic element is shaped to substantially follow an outer contour of the second planar inverted-F antenna branch." As discussed above, the parasitic element 230 in Petteri is not a floating parasitic element as claimed. Furthermore, although no particular guidance is given as to which portions of Petteri are relied upon by the Official Action in rejecting Claim 28, it appears that the Official Action considers the parasitic element 230 to disclose both the floating parasitic element as well as the second planar inverted-F antenna branch cited in

¹ Applicant notes that the amendment herein to the paragraph beginning at page 8, line 1 of the specification has been made to correct a typographical error, in particular, to remove an erroneous double recitation of "multi-band."

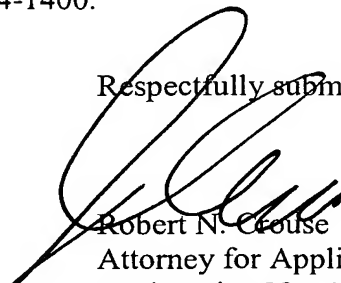
Claim 28. Assuming this to be true, Applicant notes that the parasitic element 230 in Petteri does not appear to be ohmically isolated from any other portion of the parasitic element 230. Therefore, it is unclear how the parasitic element 230 could disclose both a floating parasitic element shaped to substantially follow an outer contour of the second planar inverted-F antenna branch and the second planar inverted-F antenna branch itself (which is ohmically isolated in the floating parasitic element). *See*, for example, independent Claim 27 in conjunction with dependent Claim 28. Accordingly, dependent Claim 28 is also separately patentable for at least these additional reasons.

New dependent Claim 29 recites in part that "the floating parasitic element is configured to resonate in the first frequency band." Applicant submits that these recitations are not disclosed or suggested by any of the cited references. Accordingly, Applicant respectfully submits that new dependent Claim 29 is also separately patentable for at least these additional reasons.

CONCLUSION

Applicant has shown that Sadler is not a proper reference for use in a rejection under §103 as a matter of law. Applicant has also shown that Petteri also does not disclose or suggest the recitations of Claims 27-29. Accordingly, Applicant respectfully requests the withdrawal of all rejections and the allowance of all claims in due course. If any informal matters arise, the Examiner is encouraged to contact the undersigned by telephone at (919) 854-1400.

Respectfully submitted,



Robert N. Crouse
Attorney for Applicant
Registration No. 44,635

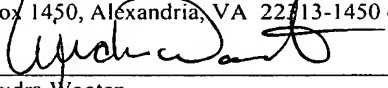
USPTO Customer No. 20792
Myers Bigel Sibley & Sajovec
Post Office Box 37428
Raleigh, North Carolina 27627
Telephone: 919/854-1400
Facsimile: 919/854-1401

In re: Scott L. Vance
Serial No.: 10/699,048
Filed: October 31, 2003
Page 11 of 11



Certificate of Mailing under 37 CFR 1.8 (or 1.10)

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on May 12, 2005.



Audra Wooten